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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/813,852 | 03/07/1997 | RODNEY L. DOCKERY | 21651.3 | 3963 |

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EXAMINER

FISCHER, ANDREW J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3627

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 08/813,852 | DOCKERY ET AL. | |
| | Examiner | Art Unit | |
| | Andrew J. Fischer | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,10,17-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 1,4,10,17 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Claims 18-23 and 25 remain pending in this application.
2. Claims 1, 4, 10, 17, and 26-28 stand withdrawn from consideration as be directed to non-elected claims.
3. This Office Action is given Paper No. 20060326.
4. Unless expressly noted otherwise, all references in this Office Action to the capitalized versions of “Appellants,” or “Applicants” refers specifically the Applicants of record. References to lower case versions of “applicant,” “applicants,” or “appellants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to the capitalized versions of “Examiner” in this Office Action refers to the Examiner of record while reference to or use of lower case versions of “examiner” or “examiners” refers to examiner(s) generally.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 18, 19, and 25 are rejected under 35 U.S.C. §102(b) as being anticipated by the telephone book The One Book for Northern Virginia for 1993 (“One Book”). It is the Examiner’s factual determination that the One Book is a periodical. The Examiner takes Official Notice that phone books are published on a early basis (*i.e.* they come out once a year). Thus, the One Book is a periodical. It is the Examiner’s factual determination that One Book is a periodical that contains articles. In this case, the Examiner finds that because One Book directly discloses a coupon section, a “recycling information” section, the “Yellow Pages and Business White Pages” section, One Book is comprised of articles when using the definitions now of record, *supra*. Because One Books is thus a periodical comprised of articles, it is the Examiner’s factual determination that One Book is a magazine. In this case, it is the Examiner’s factual determination that the advertisements for pet supplied (*e.g.* Federal Lock and Safe,” “Marinelife,” “Creatures ‘n Critters” are articles. The articles reference brand name products, *e.g.* “Iams” pet food.

8. The Examiner finds that the magazine is specific to a particular store (*e.g.* a pet store).

Claim Rejections - 35 USC §103

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18, 19, and 25 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over The One Book.¹ It is the Examiner's principle position that the claims are anticipated because of the inerencies the One Book contains articles.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the One Book to include general interest articles. Such a modification would have helped give the reader more information about the coverage of the One Book.

11. Claims 18, 20-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hawaiian Airlines² in view of The One Book. Hawaiian Airlines discloses a plurality of general interest articles dispersed throughout a magazine (see *e.g.* "Front Desk", page 15, last column, last full paragraph stating that "Hawaiian Airlines offers a deluxe 'Paradise Resorts' package that includes lei greeting and two nights at the Hyatt"); an advertisement (after page 38) directed to Hawaiian Airlines and referencing flights to and from Hawaii; the specific brand (Hawaiian Airlines) is authored under commission by a sponsor of the specific brand in said article (not only is the article under commission—the entire magazine is under commission of Hawaiian Airlines); the specific store appears on the front cover (Hawaiian Airlines appears on the cover of the magazine); and airline tickets are controlled at least in part by Hawaiian Airlines.

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

² From the Information Disclosure Statement ("IDS") filed June 9, 2004 (Paper No. 53).

Hawaiian Airlines ad (after page 38) does not directly disclose a coupon. However One teaches the use of brand specific coupons. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hawaiian Airlines advertisement (found on the page directly after page 38) to include the brand specific coupons as found in the One Book. By limited the airline tickets to Hawaiian Airlines only (and not any airline), Hawaiian Airlines ensures that the advertisements are brand specific. Such a modification would have provided Hawaiian Airlines a method of ensuring that its flight customers take home with them their complimentary copy of Hawaiian Airlines so that they could use the coupon in their next purchased flight.

The One Book directly discloses a coupons keyed to articles containing brand specific information (see e.g. “Marinelife”, “Creatures ‘n Critters” and P.T. Moran Company Pet Food Supplies” which disclose “Science Diet,” “Iams,” and “Nulro Max” “brand name pet foods”). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made modify the Royal Lahaina Luau advertisement to include a coupon for a “Hawaiian pig” or other brand name feature at the luau. Such a modification would have allowed the browsers of Hawaiian Airlines to associate a brand they are familiar with to the luau.

12. Claims 18, 22, and 25 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Shedd (U.S. 2,215,163) in view of Bullard, Jr. (U.S. 4,968,061)(“Bullard”).

13. Shedd discloses a book that is not restricted to just advertising, see page 1, col.1, lines 2 and 3. Shedd’s Book includes recipes which are articles of general interest and the recipes include a particular product of a distributor which comprises a specific brand, see page 2, col. 1, lines 21- 33 and coupons which are linked to the particular products of the distributor, see page 2, col. 1, lines 33-45. Shedd does not directly disclose that the invention can be a magazine.

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Bullard teaches at col. 2, lines 30-33 that in advertising media books and magazines are equivalent. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Bullard to execute the invention of Shedd as a magazine as well as a book since Bullard teaches in advertising media books and magazines are equivalent.

14. Claim 19 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the Shedd/Bullard combination discussed above and further view of Lamphere et. al. (U.S. 5,127,674)(“Lamphere”). The Shedd/Bullard combination discloses the claimed invention as discussed above but does not directly disclose the magazine being specific to a particular store. Lamphere shows a promotional booklet that is specific to a particular store, see col. 10, lines 51-61. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Lamphere to make the magazine of the Shedd/Bullard combination specific to a particular store to aid shoppers in finding the advertised products.

15. Claims 20, 21, and 23 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the Shedd/Bullard combination discussed above and further view of Lamphere. The Shedd/Bullard combination discloses the claimed invention as discussed above but does not directly disclose who commissioned the articles. However it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the Shedd/Bullard combination to include Lamphere (col. 9, lines 5-12) to sell advertising space in the magazine of Shedd.

Response to Arguments

16. Applicants' arguments filed January 6, 2006 have been fully considered but they are not persuasive.

17. Applicant argues that the "present application is on appeal before the Board" The Examiner disagrees since currently the application is under the jurisdiction of the Examiner.

18. Regarding Official Notice, the Examiner maintains his position as noted in the previous office action that Applicants' attempt at traversing the Official Notice was "inadequate" as defined by the MPEP.

19. Applicants' arguments regarding lexicography are noted for the record. While the Examiner does not understand them, they are noted for the record. The Examiner maintain his position that Applicants are not their own lexicographer.

20. Regarding Applicants' arguments regarding Bado, the Examiner maintains his position.

21. Applicant argues that that "*One Book* does not contain articles containing brand specific information or coupons keyed to the articles." The Examiner respectfully disagrees because the Examiner maintains is definition of "article" as noted in the Office action mailed April 13, 2005.

22. Regarding Continental Can, the Examiner maintains his position that *Continental Can* is not binding on examiners because it involves inter partes litigation. See MPEP 2111.01.

23. Regarding inherency, Applicants' standard of proof is too exacting. If the disclosure of the prior art is sufficient to show that the natural result flowing from the operation as taught in the prior art would result in the claimed structure or method, then those features are inherent.

24. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence

provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "AJ Fischer", followed by the date "3/24/06".

Andrew J Fischer
Primary Examiner
Art Unit 3627

AJF
March 26, 2006